

REMARKS

Claims 1-93 are pending in the present application. The Examiner has allowed claims 33-38 and 70-75 and has rejected claims 1-32, 39-69 and 76-93.

I. ATTORNEY DOCKET NUMBER

Applicants respectfully request that the attorney docket number be changed in the present application. Kindly replace "40884/CAG/B600" with -15258US06-.

II. ALLOWED CLAIMS

Applicants would like to thank the Examiner for indicating that claims 33-38 and 70-75 are allowed.

**III. REJECTION UNDER 35 U.S.C. § 103(a) WITH
RESPECT TO CLAIMS 1-32, 39-69 AND 76-93**

Claims 1-32, 39-69 and 76-93 stand rejected under 35 U.S.C. § 103(a) as being obvious over U.S. Patent No. 6,285,865 B1 ("Vorenkamp") in view of U.S. Patent No. 6,587,678 B1 ("Molnar"). Applicants respectfully traverse the rejection.

VORENKAMP DISQUALIFIED AS A REFERENCE UNDER 35 U.S.C. § 103

35 U.S.C. § 103(c) states that

[s]ubject matter developed by another person, which qualifies as prior art only under one or more subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Subject Matter Developed By Another Person

Applicants respectfully submit that Vorenkamp is subject matter developed by another person. Vorenkamp is entitled "System and Method for On-Chip Filter Tuning" and lists three inventors: Pieter Vorenkamp; Klaas Bult; and Frank Carr. The present application lists two inventors: Shervin Moloudi and Maryam Rofougaran. Thus, since there is not even one common inventor, Vorenkamp clearly is "subject matter developed by another person" in compliance with 35 U.S.C. § 103(c).

Qualifies as Prior Art Only Under Subsection (e) of Section 102

Applicants respectfully submit that Vorenkamp only qualifies as prior art under subsection (e) of Section 102. 35 U.S.C. § 102(e) states, in relevant part, that “[a] person shall be entitled to a patent unless ... (e) the invention was described in ... a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent”

Assuming the earliest U.S. provisional application provides an effective U.S. filing date, Vorenkamp has an effective filing date of November 12, 1998 and an actual filing date of November 12, 1999. In addition, Vorenkamp issued as a patent on September 4, 2001. Thus, Vorenkamp “qualifies as prior art only under one or more subsections (e), (f), and (g) of section 102 of this title” in further compliance with 35 U.S.C. § 103(c).

Shall Not Preclude Patentability Under Section 103 Where the Subject Matter and the Claimed Invention Were, at the Time the Invention Was Made, Owned by the Same Person or Subject to an Obligation of Assignment to the Same Person

Applicants respectfully submit that Vorenkamp and the present application were, at the time the present invention was made, owned by the same person or subject to an obligation of assignment to the same person. As indicated on the face of the patent, the subject matter of Vorenkamp was assigned solely to the *Broadcom Corporation of Irvine, California*. On the actual filing date (i.e., October 27, 2000) of the present application, the claimed invention was owned or subject to an obligation of assignment solely to the *Broadcom Corporation of Irvine, California*. The Examiner is invited to examine the recorded assignment document at Reel/Frame No. 011595/0804, executed November 20, 2000 and recorded March 13, 2001 for the present application. Additional information about the parent application of the present application or priority documents (e.g., U.S. provisional applications) of the parent application can be provided, if requested by the Examiner; however, M.P.E.P. 706.02(l)(1)¹ appears to support the contention that the claimed invention need only be owned by the same company or

¹ M.P.E.P. § 706.02(l)(1) states that “[t]he mere filing of a continuing application on or after November 29, 1999, with the required evidence of common ownership, will serve to exclude commonly owned 35 U.S.C. 102(e) prior art that was applied, or could have been applied, in a rejection under 35 U.S.C. 103 in the parent application.”

subject to an obligation of assignment to the same company as of the filing day of the continuing application.

Therefore, Vorenkamp "shall not preclude patentability under this section [i.e., Section 103] where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person" in full compliance with 35 U.S.C. § 103(c).

REJECTION UNDER 35 U.S.C. § 103(a) CANNOT BE MAINTAINED

Applicants respectfully submit that the Examiner cannot maintain a rejection under 35 U.S.C. § 103(a) over Vorenkamp in view of Molnar since Vorenkamp is disqualified as a 35 U.S.C. § 103 reference as set forth in 35 U.S.C. § 103(c).

Since the Examiner cannot maintain an obviousness rejection over Vorenkamp in view of Molnar, Applicants respectfully request that the rejection under 35 U.S.C. § 103(a) be withdrawn with respect to claims 1-32, 39-69 and 76-93.

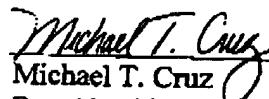
IV. CONCLUSION

In view of at least the foregoing, it is respectfully submitted that the pending claims 1-93 are in condition for allowance. Should anything remain in order to place the present application in condition for allowance, the Examiner is kindly invited to contact the undersigned at the below-listed telephone number.

Please charge any required fees not paid herewith or credit any overpayment to the Deposit Account of McAndrews, Held & Malloy, Ltd., Account No. 13-0017.

Dated: April 27, 2004

Respectfully submitted,


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